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10/615,026

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Francisco Martinez de Velasco Cortina

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8769

23562

7590

10/20/2005

BAKER & MCKENZIE  
PATENT DEPARTMENT  
2001 ROSS AVENUE  
SUITE 2300  
DALLAS, TX 75201

EXAMINER

TRIEU, VAN THANH

ART UNIT

PAPER NUMBER

2636

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/615,026

**Applicant(s)**CORTINA ET AL. **Examiner**

Van T Trieu

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☒ Claim(s) 2,4,8,10,12,14,16,18,21,23,25,27 and 28 is/are allowed.  
6) ☒ Claim(s) 1,3,5-7,9,11,13,15,17,19,20,22,24,26 and 29-52 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 7/9/03 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Oath/Declaration***

1. It does not identify the citizenship of the first inventor CORTINA.

Applicant is now required to submit a substitute declaration or oath to correct the deficiencies set forth as above. The substitute oath or declaration must be filed within the THREE MONTH shortened statutory period set for reply in the "Notice of Allowability" (PTO-37). Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136. Failure to timely file the substitute declaration (or oath) will result in **ABANDONMENT** of the application. The transmittal letter accompanying the declaration (or oath) should indicate the date of the "Notice of Allowance" (PTOL-85) and the application number in the upper right hand corner.

### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed "radio frequency antenna embedded on a chip" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure

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number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the claimed limitation of "radio frequency antenna embedded on a chip" is not described in the specification. However, the specification only describes that Figure 1 illustrates an overview system diagram 100, according to one embodiment of the present invention. This embodiment comprises an RF device 110 connected to or embedded on an RF identification mechanism 105, and an RF reader/writer 125. The RF device 110 includes a chip 115 and an RF antenna 120." Examiner reviews Figure 1 showing that the IC chip 115 and RF antenna 120 are embedded on the RF device, smart card or ID card that can be attached to any objects, clothes, baggage, license plate, passport, animals and/or items to be tracked.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1, 3, 7, 9, 11, 13, 15, 17, 20, 22, 24, 26, 49 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Diamond et al** [US 6,698,653] in view of **Karasawa et al** [EP 0977145].

Regarding claim 1, the claimed the radio frequency identification mechanism incorporating the radio frequency device (the smart card or tag RFID 32 such as RF baggage tag, RFID card and/or RFID boarding pass, RFID driver's license, bracelet, see Fig. 1, col. 1, lines 6-22 and col. 7, lines 1-7 ; and the radio frequency reader to read information from the radio frequency device (the smart card reader 55, see Fig. 5,

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col. 7, line 64 and col. 8, lines 4-80); but **Diamond et al** fails to disclose the radio frequency device comprising a radio frequency antenna embedded on a chip. However, **Diamond et al** teaches that microchip 10, 31 or 41 can be affixed or attached to a foil strip 11 provided with a loop antenna 12 as a smart card, see Figs. 1, 3 and 4, col. 6, lines 63-65, col. 7, lines 51-58 and col. 9, lines 1-56). **Karasawa et al** suggests that a radio IC card comprises a first antenna coil 22 is formed on a surface of an IC chip 23, which is buried in plastic card, etc., see Fig. 14, page 2, lines 3-5 and page 8, lines 35-37. Therefore, it would have been obvious to one skill in the art at the time the invention was made to substitute the RF antenna formed on a surface of an IC chip of Karawasa et al for the microchip and antenna of **Diamond et al** since the microchip and antenna are electrically connected together and may be secured overlap each other as shown in Figure 1 of **Diamond et al**.

Regarding claim 3, all the claimed subject matters are met by the combination between **Diamond et al** and **Karasawa et al** in respect to claim 1 above, and including the verifying registration, see col. 1, lines 13-15 and col. 9, lines 55-59).

Regarding claim 7, all the claimed subject matters are met by the combination between **Diamond et al** and **Karasawa et al** in respect to claim 1 above, and including the passenger/driver's facial biometrical, see col. 3, lines 58-61.

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Regarding claim 9, all the claimed subject matters are met by the combination between **Diamond et al** and **Karasawa et al** in respect to claim 1 above, and including identifying an airport passenger.

Regarding claim 11, all the claimed subject matters are met by the combination between **Diamond et al** and **Karasawa et al** in respect to claims 1 and 7 above.

Regarding claim 13, all the claimed subject matters are met by the combination between **Diamond et al** and **Karasawa et al** in respect to claim 9 above, and including the passport and identification card, see col. 3, line 61.

Regarding claim 15, all the claimed subject matters are met by the combination between **Diamond et al** and **Karasawa et al** in respect to claim 9 above, and including the wireless communication smart card, 9, lines 17-36.

Regarding claim 17, all the claimed subject matters are met by the combination between **Diamond et al** and **Karasawa et al** in respect to claims 7 and 15 above.

Regarding claim 20, all the claimed subject matters are met by the combination between **Diamond et al** and **Karasawa et al** in respect to claim 1 above, and including the RF decal (registration card, col. 1, lines 12-13).

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Regarding claim 22, all the claimed subject matters are met by the combination between **Diamond et al** and **Karasawa et al** in respect to claims 7 and 17 above, and including the personal acknowledge (the passenger image and data, see col. 3, lines 58-67 and col. 4, lines 1-8).

Regarding claim 24, all the claimed subject matters are met by the combination between **Diamond et al** and **Karasawa et al** in respect to claims 1 and 9 above, and including the airport.

Regarding claim 26, all the claimed subject matters are met by the combination between **Diamond et al** and **Karasawa et al** in respect to claims 7 and 22 above.

Regarding claim 49, all the claimed subject matters are met by the combination between **Diamond et al** and **Karasawa et al** in respect to claim 1 above, and including the photograph and multi-dimensional bar codes, see col. 3, lines 37-67 and col. 4, lines 1-8.

Regarding claim 51, all the claimed subject matters are met by the combination between **Diamond et al** and **Karasawa et al** in respect to claim 49 above.

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5. Claims 5, 6, 29-32 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Diamond et al** and **Karasawa et al** and further in view of **Mish** [US 6,025,784].

Regarding claim 5, all the claimed subject matters are met by the combination between **Diamond et al** and **Karasawa et al** in respect to claim 1 above, but **Diamond et al** fails to disclose the license plate incorporating the radio frequency device. However, **Diamond et al** teaches that the RF strip 11 is incorporated with an identification object such as a boarding pass, baggage tag, bracelet, identity card, driver' license and a person social security number and address is identified a license plate, see col. 7, lines 1-15. **Mish** suggests that the RFID 28 is incorporated with the vehicle license plate frame 10 and/or any location on the vehicle's windows, see Figs. 1-4, abstract, col. 1, lines 41-62, col. 2, lines 37-64, col. 3, lines 8-27 and col. 5, lines 18-31. Therefore, it would have been obvious to one skill in the art at the time the invention was made to implement the RIFD tag of **Diamond et al** and **Karasawa et al** with the vehicle's license plate of **Mish** since the RFID is adapted to use as a license plate for a person or an individual. Extending application of the RFID tag will not affect or changing its operations and purposes of monitoring and tracking objects, persons and/or animals.

Regarding claim 6, all the claimed subject matters are met by the combination between **Diamond et al** and **Karasawa et al** and **Mish** in respect to claim 5 above, and including the step of storing first identification information on a chip with a radio frequency antenna (the E-PROM, see col. 2, lines 52-55, col. 3, lines 22-26 and 58-67, col. 6, lines

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65-67 and col. 7, lines 1-28); and comparing the first identification information with second identification information to determine if a match exists (comparing the read digital data, see col. 2, lines 59-67, col. 3, lines 28-30 and col. 7, lines 21-49).

Regarding claim 29, all the claimed subject matters are met by the combination between **Diamond et al** and **Karasawa et al** and **Mish** in respect to claims 1 and 5 above.

Regarding claim 30, all the claimed subject matters are met by the combination between **Diamond et al** and **Karasawa et al** and **Mish** in respect to claim 29 above, and including the sticker (the adhesive for attaching the RFID tag, see **Mish**, col. 5, lines 18-32.

Regarding claim 31, **Diamond et al** fails to disclose the identification mechanism is a window sticker. However, **Diamond et al** teaches that the RFID smart card uses as a vehicle registration card for identifying that vehicle and owner, see col. 1, lines 13-14. Since the vehicle's registration paper or tag is placed on the windshield/window of the vehicle. **Mish** suggests that the RFID tag is adhered to the vehicle's window, see Fig. 5, col. 5, lines 18-32. Therefore, It would have been obvious to one skill in the art at the time the invention was made to attached the RFID smart card containing vehicle's registration of **Diamond et al** and **Karasawa et al** to the window of **Mish** for easily identify and recognize by a user or police office and also preventing of fraud.

Regarding claim 32, all the claimed subject matters are met by the combination between **Diamond et al** and **Karasawa et al** and **Mish** in respect to claims 1 and 29 above.

Regarding claim 34, all the claimed subject matters are met by the combination between **Diamond et al** and **Karasawa et al** and **Mish** in respect to claim 29 above, and including the IC or microchip 10, see Fig. 1.

6. Claims 33 and 35-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Diamond et al** and **Karasawa et al** and further in view of **Look** [US 6,894,615]. Regarding claim 33, **Diamond et al** fails to disclose the identification mechanism is a retroreflective article. However, **Diamond et al** teaches that the identification mechanism is a window sticker. However, **Diamond et al** teaches that the RFID smart card uses as a vehicle registration card for identifying that vehicle and owner, see col. 1, lines 13-14. **Look** suggests incorporated both a retro-reflective article 12, 112 or 40 and an RFID tag 10, 110 or 42 to be placed inside of a vehicle window or at the vehicle's license plate, see Figs. 1—5 and 8, see abstract, col. 1, lines 44-60, col. 2, lines 21-64, col. 4, lines 62-67, col. 5, lines 1-38 and col. 7, lines 14-26. Therefore, it would have been obvious to one skill in the art at the time the invention was made to substitute the retro-reflective article with RFID tag of **Look** for the RFID smart card of **Diamond et al** and **Karasawa et al** for use to any environment conditions such as the

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vehicle's license plate for protection against fraud or counterfeiting, see **Look**, col. 1, lines 34-41.

Regarding claim 35, all the claimed subject matters are discussed between **Diamond et al** and **Karasawa et al** and **Look** in respect to claim 33 above, wherein the RFID tag is incorporated with vehicle's license plate for storing vehicle's registration and information, see Fig. 8 of **Look**, col. 1, lines 34-41 and col. 7, lines 14-38.

Regarding claim 36, all the claimed subject matters are discussed between **Diamond et al** and **Karasawa et al** and **Look** in respect to claim 35 above, and including the window sticker, see col. 1, lines 7-13 and 46-67.

Regarding claim 37, all the claimed subject matters are discussed between **Diamond et al** and **Karasawa et al** and **Look** in respect to claim 36 above.

Regarding claim 38, all the claimed subject matters are discussed between **Diamond et al** and **Karasawa et al** and **Look** in respect to claims 32 and 35 above.

Regarding claim 39, all the claimed subject matters are discussed between **Diamond et al** and **Karasawa et al** and **Look** in respect to claim 35 above.

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Regarding claim 40, all the claimed subject matters are discussed between **Diamond et al** and **Karasawa et al** and **Look** in respect to claims 7 and 35 above.,

Regarding claim 41, all the claimed subject matters are discussed between **Diamond et al** and **Karasawa et al** and **Look** in respect to claims 1 and 35 above.

Regarding claim 42, all the claimed subject matters are discussed between **Diamond et al** and **Karasawa et al** and **Look** in respect to claims 1 and 33 above.

Regarding claim 43, all the claimed subject matters are discussed between **Diamond et al** and **Karasawa et al** and **Look** in respect to claims 1 and 33 above.

Regarding claim 44, all the claimed subject matters are discussed between **Diamond et al** and **Karasawa et al** and **Look** in respect to claim 42 above.

Regarding claim 45, all the claimed subject matters are discussed between **Diamond et al** and **Karasawa et al** and **Look** in respect to claim 33 above, and including the step of storing first identification information on a chip with a radio frequency antenna (the E-PROM, see col. 2, lines 52-55, col. 3, lines 22-26 and 58-67, col. 6, lines 65-67 and col. 7, lines 1-28); and comparing the first identification information with second identification information to determine if a match exists (comparing the read digital data, see col. 2, lines 59-67, col. 3, lines 28-30 and col. 7, lines 21-49).

Regarding claim 46, all the claimed subject matters are discussed between **Diamond et al** and **Karasawa et al** and **Look** in respect to claims 7 and 45 above.

Regarding claim 47, all the claimed subject matters are discussed between **Diamond et al** and **Karasawa et al** and **Look** in respect to claim 45 above.

Regarding claim 48, all the claimed subject matters are discussed between **Diamond et al** and **Karasawa et al** and **Look** in respect to claims 33 and 45 above.

7. Claims 50 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Diamond et al** and **Karasawa et al** and further in view of **Janssen et al** [US 6,427,504].

Regarding claim 50, **Diamond et al** fails to disclose the RFID mechanism is subjected to at least one of: a static bending test, a heat test, a rigidity test, a durability test; and an abrasion test. However, **Diamond et al** teaches that the RFID chip 10 and antenna 12 are constructed as a tag 11 in the form of a boarding pass, baggage tag, bracelet, ID card, driver's license, see Figs. 1 and 5, col. 1, lines 7-22 and col. 7, lines 1-7. **Janssen et al** suggests that an RFID system including a transponder 2 and antenna 3 are carefully selection of construction materials and structural design, so that a delicate balance is achieved in the improved key design. The materials are selected of a flexible or rigid material such as plastic for protecting the RFID tag from any environmental

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conditions. The testing has demonstrated of the thermal heat, rigidity, flexibility and bending of the RFID tag are critical to the transmission of the RFID tag system, see Figs. 1-54, col. 3, lines 1-62, col. 9, lines 12-33, col. 16, lines 47-67, col. 17, lines 33-67, col. 18, lines 1-67, col. 19, lines 1-27 and col. 20, lines 4-17. Therefore, it would have been obvious to one skill in the art at the time the invention was made to implement the RFID system testing of **Janssen et al** to the RFID tag of **Diamond et al** and **Karasawa et al** during structure assembly line of the RFID tag for assuring and improving of the quality, reliability and durability of the RFID tag.

Regarding claim 52, all the claimed subject matters are discussed between **Diamond et al** and **Karasawa et al** and **Janssen et al** in respect to claims 2 and 50 above.

### ***Response to Arguments***

Applicant's arguments filed on 15 August 2005 have been fully considered but they are not persuasive. Because,

#### Applicant's arguments:

- (A) **Diamond et al** do not teach a radio antenna embedded on a chip.
- (B) **Diamond et al** do not teach attaching an identification mechanism tag to a license plate or any other part of a vehicle.
- (C) **O'Brient** cannot makeup for the deficiencies of **Diamond et al**.
- (D) **Janssen** does not makeup for the deficiencies of **Diamond et al**.

**Response to the arguments:**

(A) The application did not shown and taught of the RF antenna embedded on the IC chip, instead it only shown both the antenna and IC chip are embedded on an RF device or smart card. Secondly, a new reference of **Karasawa et al** is combined to support the structure between the antenna and the IC chip, wherein the antenna is attached or embedded on the IC chip, as well as shown they are overlapped one another by Figure 1 of **Diamond et al**.

(B) It is obvious to combine **Diamond et al** with **Mish** for incorporating the RFID tag with the vehicle's license plate since the RFID is used as a license plate for a person's identity and information, and as well as vehicle's ID and information data.

(C) A new reference of **Look** makes up the retro-reflective article deficiencies of **Diamond et al** is obvious because the RFID is designed to be used with variety of applications and at any environmental conditions, such as vehicle's license plate for preventing damage and fraud.

(D) It is obvious to combine between **Diamond et al** and **Jannsen** because it is well known of the structure to make a semiconductor IC chip and RFID card being protected from any environmental conditions and preventing of fraud and losing information data.

**Conclusion**

8. Claims 2, 4, 8, 10, 12, 14, 16, 18, 21, 23, 25, 27 and 28 is allowable over the prior art.

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9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from examiner should be directed to primary examiner **Van Trieu** whose telephone number is (571) 272-2972. The examiner can normally be reached on Mon-Fri from 7:00 AM to 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. **Jeffery Hofsass** can be reached on (571) 272-2981.



**Van Trieu**  
**Primary Examiner**  
**Date: 10/19/05**